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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/755,627      | 01/04/2001  | Freddie Geier        | 001580-718          | 2986             |

7590 08/25/2005

James W. Peterson, Esq.  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

| EXAMINER |
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BOCCIO, VINCENT F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2616

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/755,627 | <b>Applicant(s)</b><br>GEIER ET AL. |  |
|                              | <b>Examiner</b><br>Vincent F. Boccio | <b>Art Unit</b><br>2616             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on Amendment of 8/12/05.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-9,12-19,21-27 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9,12-19,21-27 and 29-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

***Response to Arguments***

1. Applicant's arguments filed 6/13/05 with respect to the amended claims have been fully considered but they are not persuasive.

{A} In re pages 7-, applicant states, Kanazawa fails to anticipate the limitation, wherein, "the starting and providing steps are not done under the control of the DVD player software".

It is first noted in applicant's specification, at page 2, which states, "the embedded information is supported by the operating system, preferable an extension to the operating system.", and,

page 3, "By using operating system software, in particular operating system extension software.".

Based on the previous passages, Kanazawa, since has an embodiment on a PC Fig. 17, as stated in the last action, the PC has an operating system which performs all operations, as disclosed, wherein, "to function with the DVD with URLs", the operating system of the PC is loaded with DVD software being drivers, programs, therefore, as compared to the embodiment with no PC, when no PC, uses the DVD player software only. When on a PC, it is the operating system with extensions or drivers or added software, which performs the starting and providing steps, therefore anticipates the claims based on the embodiment being a PC having an operating system, loaded with drivers or in other words the operating system with extensions, being software, programs, drivers being part of the operating system, therefore, not under control of the DVD player software alone, but the operating system with DVD player software loaded thereto in order to operate.

Therefore, as claimed Kanazawa anticipates that the starting and providing steps are not done under control of the DVD player software, ALONE, but, being a PC the operating system performs the steps and not the DVD player software alone.

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Further, on an alternate interpretation, IF there exists no drivers or DVD player software in the operating system, associated with the system on the PC, the system would not be enabled.

Therefore, would not provide the URL to the browser, by having no DVD player software which is required to operate, there requires a nexus between the software and browser or the system would not operate.

The only reason the examiner is not rejecting the claims under 112 Para 1, is because the examiner knows that the player software loaded to the computer is required to be there or the system would not operate without some form of DVD player software in the operating system, which is an extension of the operating system.

If there is no DVD player software anywhere the examiner would render the system inoperable and reject under 112 Para 1, under enablement, but, the examiner understands that the claims should be read in light of the specification, wherein the DVD player software, is an extension program, software or known as drivers or API, or without would be inoperable.

Therefore, on the PC level with an operating system the drivers either from the DVD or other, are required to be loaded to the operating system of the PC, in order to operate, when on a PC level having an operating system is required to be loaded to the operating system, known as an extension software with respect to the PC to extend the operability to do more than the original operating system without the DVD player software to handle the DVD with URLs to allow user interactions, selecting the WEB button, checking for the URL, when exists to trigger the browser and provide the browser with the address or URL, to pull the WEB page, as anticipated by Kanazawa, as those skilled in the art would understand.

The primary examiner invites applicant to discuss the issues to clarify the positions of the examiner or applicant and offers assistance to determine distinctness of either the presented claims in present form or to assist in locating more deemed distinguishable features to amend to.

**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 2-9, 12-19, 21-27, 29-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanazawa et al. (US 6,580,870).

The examiner incorporates by reference the last action against the claims.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanazawa et al. (US 6,580,870).

The examiner incorporates by reference the last action against the claims.

**Conclusion**

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Contact Fax Information**


Any response to this action should be faxed to:

(571) 273-8300, for communication as intended for entry, this Central Fax Number as of 7/15/05

**Contact Information**

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent  
8/16/05

  
VINCENT BOCCIO  
PRIMARY EXAMINER